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REMARKS

Claims 1, 3-12, 15-25, 27-31, and 33-41 are pending in this application.

The Office Action rejects, under 35 U.S.C. § 102, claims 1, 3-12, 14-16, 18-21, 23-31, 33-38, and 40-41 over Haarsten (U.S. Patent No. 6,112,088). The Office Action also rejects, under 35 U.S.C. § 103, claim 17 over Haarsten and Haddad (U.S. Patent Pub. No. 2003/0117978) and claims 2, 13, and 32 over Haarsten and Kallio (U.S. Patent Pub. No. 2002/0147008). While claims 2, 13 and 32 are no longer pending, the Response to Arguments section appears to impart the respective rejections onto pending claims 1, 5, 21, 31, 35, and 38. The Office Action comments on claims 22, 39, and 41, but does not explicitly reject them based on a statutory basis or cited reference and only "notes" the rejection of claims 2, 13, 32, and 41. These rejections are respectfully traversed.

Haarsten and Kallio Fail to Teach or Suggest all of the Claimed Features

As an example, Applicants maintain Haarsten and Kallio fail to teach or suggest a method or corresponding apparatus including:

- entering an ongoing communication on the cellular radio access network,
 - detecting the presence of a wireless local area network, the wireless local area network being uncoordinated with the cellular radio access network,
 - sending a transfer request to the wireless local area network requesting transfer of the ongoing communication from the cellular radio access network to the wireless local area network, and
 - transferring the ongoing communication from the cellular radio access network to the wireless local area network
- as recited in independent claim 1.

In particular, Haarsten and Kallio do not disclose sending a transfer request to a wireless local area radio access network to a cellular radio access network requesting transfer of a communication from the cellular radio access network to the wireless local area network.

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In particular, Kallio expressly teaches, to request a transfer from a GSM network to a wireless LAN, the mobile station sends a measurement report to a base station of the cellular radio access network (paragraph 0012). A base station is not at the wireless local area network because it is part of the cellular radio access network. This is the opposite of what is claimed because it teaches initiating the transfer via a cellular radio access network. To the contrary, Applicants are expressly claiming sending a transfer request to the wireless local area network requesting transfer of the ongoing communication from the cellular radio access network to the wireless local area network.

Haarsten fails to make up for the deficiencies of Kallio. In particular, the Office Action admits Haarsten fails to teach sending a transfer request to the wireless local area network requesting transfer of an ongoing communication from the cellular radio access network to the wireless local area network by stating, "what is lacking is the first RAN being a cellular network and the second RAN being a WLAN." To elaborate, Haarsten is directed to transferring a mobile terminal from a private network to a public land mobile network (Title, Fig. 4, col. 11, lines 1-6). Applicants are claiming the opposite of what is taught by Haarsten. In particular, Applicants expressly claim sending a transfer request to the wireless local area network requesting transfer of an ongoing communication from the cellular radio access network to the wireless local area network.

Accordingly, both Kallio and Haarsten fail to teach or suggest sending a transfer request to the wireless local area network requesting transfer of an ongoing communication from the cellular radio access network to the wireless local area network, as recited in independent claim 1.

There is no Motivation to Combine the Cited References

Furthermore, Applicants maintain the Office Action still has not provided proper motivation to combine the references. In particular, Applicants expressly indicated how the references teach away from the claimed combination. In response, the Office Action alleged motivation is based on:

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- The references qualify as "analogous art."
- Both the references are similar.
- The references' similarities are sufficient enough to qualify them as being analogous art.

Unfortunately, such allegations do not overcome the fact that the references teach away from the claimed combination. In fact, such allegations do not even provide proper motivation to combine the cited references. Such allegations only amount to alleging the references can be combined because they are similar or analogous. However, "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (MPEP § 2143.01(III) citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Thus, the allegations do not provide proper motivation to combine the cited references.

The Office Action goes on to allege, "Kallio teaches that sometimes a WLAN might provide better service than a cellular network in a given area," and that such a teaching provides sufficient motivation to combine the references. Applicants agree that Kallio teaches "there is a need for providing seamless mobility between a GSM network and a different local radio network, particularly when the local radio network is used in hotspot areas or an area where higher bit rate or high quality of service (QoS) is desirable without having different terminals, devices and numbers" (paragraph 0009). However, such teaching does not change the fact that Kallio teaches away from the claimed invention. In particular, Applicants expressly claim, "sending a transfer request to the wireless local area network requesting transfer of the ongoing communication from the cellular radio access network to the wireless local area network." To the contrary, Kallio expressly teaches, to request a transfer the mobile station sends a measurement report to a base station of the cellular radio access network (paragraphs 0012 and 0049). A base station is not the wireless local area network because it is part of the cellular radio access network. Thus, Kallio teaches away from sending a transfer request to the wireless local

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area network requesting transfer of the ongoing communication from the cellular radio access network to the wireless local area network.

Applicants arguments from the previous Amendment are included as a courtesy below:

Applicants assert that Haarsten and Kallio do not disclose or suggest sending a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 1.

Applicants also assert that Haarsten and Kallio do not disclose or suggest sending a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 5.

Applicants additionally assert that Haarsten and Kallio do not disclose or suggest receiving a transfer request from a second radio access network to a first radio access network requesting initiating a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 21.

Applicants further assert that Haarsten and Kallio do not disclose or suggest a transfer request module coupled to a controller, the transfer request module configured to send a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 31.

Applicants also assert that Haarsten and Kallio do not disclose or suggest a transfer request communication module configured to send a transfer request from a second radio access

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network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 35.

Applicants additionally assert that Haarsten and Kallio do not disclose or suggest a transfer request module configured to receive a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 38.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Applicants assert the cited references do not provide a suggestion or motivation to combine the reference teachings and such is not provided by the Office Action. In particular, the Office Action only alleges "The motivation for using Kallio's teaching can be found in Kallio." However, Applicant cannot find any teaching in Kallio for combining its teachings with the specific radio communication system and method for mobile assisted handover between a private network and a public mobile network taught in Haarsten.

In fact, Applicants assert Kallio teaches away from the claimed invention. In particular, Kallio expressly teaches that during an active handover, when the mobile station initiates a handover from the GSM network to the wireless LAN, the mobile station sends a measurement report to a base station where the handover algorithm generates a handover request to the mobile switching center of the GSM network (paragraphs 0012, 0043, 0044, 0047, and 0049). In this

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case, the GSM network is allegedly the first radio access network that is a cellular network and the wireless LAN is the second radio access network. However, contrary to the claimed invention, a handover algorithm at the base station of the first radio access network generates the handover request. This is the opposite of the claimed sending a transfer request from the second radio access network to the first radio access network because the transfer request in Kallio is generated by the first radio access network.

To simplify, the claimed invention sends a transfer request from the second radio access network to the first radio access network. To the contrary, Kallio teaches the first radio access network generates the handover request. Thus, Kallio cannot send the handover request from the second radio access network to the first radio access network because it is already generated at the first radio access network. Consequently, Kallio teaches the opposite of the second radio access network sending a transfer request to the first radio access network. Therefore, Kallio teaches away from the claimed invention.

For the same reasons that Kallio teaches away from the claimed invention, neither reference discloses the claimed invention. In particular, Haarsten does not disclose the first radio access network being a cellular radio access network and the second radio access network being a wireless local area network and such is admitted by the Office Action. Furthermore, Kallio does not make up for the deficiencies of Haarsten. In particular, Kallio does not disclose sending a transfer request from a wireless local area radio access network to a cellular radio access network. As discussed above, Kallio actually teaches the opposite of the claimed invention.

Applicants recognize that one reading the claimed invention may begin to recognize numerous benefits that suddenly become apparent only after reading the claimed invention. The more the exact words of the claims are read, the more one can realize the benefits only became apparent after reading Applicants' teachings. Upon reaching this realization, it is easy to notice that there is absolutely no evidence of motivation in the prior art and such evidence has not been provided by the Office Action. Furthermore, the Office Action has not alleged motivation is based on the nature of the problem to be solved or based on the knowledge of persons of ordinary skill in the art. Yet, such motivation is required for a proper rejection under 35 USC § 103 (*see* MPEP § 2143.01). Thus, once one notices there is no evidence of motivation in the

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prior art, one can understand that the Office Action has applied impermissible hindsight in attempting to combine the references.

Thus, Haarsten and Kallio do not disclose or suggest sending a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 1.

Also, Haarsten and Kallio do not disclose or suggest sending a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 5.

Additionally, Haarsten and Kallio do not disclose or suggest receiving a transfer request from a second radio access network to a first radio access network requesting transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the second radio access network comprises a wireless local area network and the first radio access network comprises a cellular radio access network, as recited in independent claim 21.

Furthermore, Haarsten and Kallio do not disclose or suggest a transfer request module coupled to a controller, the transfer request module configured to send a transfer request to a second radio access network requesting transfer of an ongoing communication from a first radio access network to the second radio access network, wherein the first radio access network is a cellular radio access network and wherein the second radio access network is a wireless local area network, as recited in independent claim 31.

Also, Haarsten and Kallio do not disclose or suggest a transfer request communication module configured to send a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network

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comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 35.

Additionally, Haarsten and Kallio do not disclose or suggest a transfer request module configured to receive a transfer request from a second radio access network to a first radio access network requesting initiation of a transfer of an ongoing communication from the first radio access network to the second radio access network, wherein the first radio access network comprises a cellular network and the second radio access network comprises a wireless local area network, as recited in independent claim 38.

Therefore, Applicants respectfully submit that independent claims 1, 5, 21, 31, 35, and 38 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of the pending claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

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The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



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Dated: December 11, 2006

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